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RONALD M. ANDERSON MICROSOFT CORPORATION 600 108TH AVENUE N.E., SUITE 507 BELLEVUE, WA 98004			PAULA, CESAR B	
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			2178	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,821

Applicant(s)

LEVINE ET AL.

Examiner

CESAR B. PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, and 10-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the remarks filed on 10/17/2005.

This action is made Final.

2. In the remarks, claims 1-8, and 10-33 are pending in the case. Claims 1, 18, and 24 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 15-16, 24-25, 27-28, and 29-31 remain rejected under 35 U.S.C. 103(a) as being anticipated by Corel Wordperfect 6.1, 1996, hereinafter Wordperfect, "Scan Images into Wordperfect", and "Scanner Setup", "Image Settings", and "Image Tools" printouts, in view of "Twain White Paper", hereinafter Twain, <http://www.twain.org>, 1996, pp. 1-4, as cited in paper 18.

Regarding independent claim 1, Wordperfect teaches the acquisition, and insertion of a scanned image(s), from a TWAIN scanner, under control of a wordprocessing application, into a

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textual document(s) located in a Wordprocessing application (pages 1, 5). In other words, the scanner is activated once user selects the “Acquire” command from the “Insert” menu. The insertion of the scanned image(s) into the textual document(s) is done directly from the scanner, that is without saving the image into a permanent file in the computer memory prior to inserting the file into the textual document. Wordperfect fails to explicitly disclose: *(b) using a special application programming interface (API) module accessed from within the application program, for interfacing the application program with a TWAIN module that is used for acquiring an image...the special API module providing a user interface that is presented to a user within and under control of the application, said API module isolating a user from directly interacting with the TWAIN module and thereby simplifying the step of acquiring the image, (c) causing the application program to negotiate with the image source device that is active to determine a set of image capture parameters that control said image source device when acquiring the image.*

However, Twain discloses a SAPI-- *a special application programming interface (API) module* -that allows a user’s selection to trigger negotiated settings by a negotiation process between an application-- *causing the application program to negotiate--*, describing the data it wants, and a source device, defining the data it can provide. In other words, the SAPI interface allows the application to acquire an image through a “Source Manager” which contacts a “Source Driver”—*TWAIN module--* which represents the hardware device used to acquire the image. The application has to go through the SAPI, and the “Source Manager” in order to access the “Source driver”, thereby isolating the user of the application from the driver of the acquisition device (page 4, lines 8-17, page 2, parag.4, page 3, parag.3-4). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of

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Wordperfect, and Twain, and access the SAPI from within the application to communicate or interact with the driver, because Wordperfect discloses the acquisition of images from a scanner directly from the user using TWAIN (page 1). Twain teaches providing a consistent, and easy integration of image data between sophisticated input devices, and software applications (page 1, parag. 2, page3, parag.2). Thus, easily and promptly scanning images into a document in real time.

Claim 3 is directed towards a method for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 15, which depends on claim 12, Wordperfect discloses the automatic scan of images into a document using only TWAIN enabled scanners, thereby determining whether the device(s) is TWAIN compliant, and only using a single user selection of an “acquire” option from an insert menu (pages 1-2).

Claim 16 is directed towards a computer-readable medium for storing the steps found in claim 1, and therefore is similarly rejected.

Claims 24-25 are directed towards a system for implementing the steps found in claims 1, and 1 respectively, and therefore are similarly rejected.

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Regarding claim 27, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) produced with a wordprocessor—*presentation design application* (pages 1-2, 5).

Regarding claim 28, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) (pages 1-2, 5).

Claim 29 is directed towards a system for implementing the steps found in claim 15, and therefore is similarly rejected.

Regarding claim 30, which depends on claim 24, Wordperfect discloses the automatic scan of images into a document using only a using a single user selection of an “acquire” option from an insert menu (page 1).

Regarding claim 31, which depends on claim 24, Wordperfect discloses allowing a user to customize or enhance the image settings to be inserted into the document. This enhancement is done from within the wordprocessor (page 7).

5. Claims 2, 6, 10, 12, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, and further in view of “Ulead PhotoImpact 3.0” User

Guide for Windows 95 and Windows NT 3.51, hereinafter Photoimpact, Ulead Systems, 1996, pp.104-107, 111-114, 162-167.

Regarding claim 2, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *a list of all image source devices in communication with the computer*. However, Photoimpact discloses the selection of a specific device from a list including all the devices connected to a pc for scanning images into the pc (page162, lines 28-38). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the selection of one device out of all the devices connected to the pc, because the computer does not know which device the user wants to use to acquire the image, the user must choose, when there are more than one device connected to the computer.

Regarding claim 6, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document (page 2). Wordperfect fails to explicitly disclose: *(a) selecting at least one image enhancement criterion, and(b) enhancing said captured image based on said image enhancement criterion, prior to inserting said data representing the image into said document*. However, Photoimpact discloses the setting of image calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer-- *prior to inserting said data representing the image into said document* (page164, line 14-page 167). It would have been obvious to a person

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of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 10, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *the set of image capture parameters are negotiated based in part on the capabilities of said image source device*. However, Photoimpact discloses the setting of calibration, and postprocessing options for adjusting, and enhancing images to be scanned into the computer (page 164, line 14-page 167). In other words, once the postprocessing options are selected, the photoimpact application negotiates with the scanning device the straightening, cropping, removing moiré, etc., -- *capture parameters are negotiated based in part on the capabilities of said image source device*-- of the image. This calibration is also based in part on the user's input. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses the benefit of correcting basic image problems, and improving the image appearance (page 165, lines 4-26).

Regarding claim 12, which depends on claim 1, Wordperfect discloses the scanning of images directly into a document (page 1). Twain discloses a SAPI-- *a special application programming interface (API) module* --that allows a user's selection to trigger the providing of

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negotiated settings by a negotiation process between an application-- *causing the application program to negotiate--*, describing the data it wants, and a source device, defining the data it can provide (page 4, lines 12-17, page 2, parag.4, page 3, parag.3-4). It would have been obvious to a person of ordinary skill in the art Wordperfect fails to explicitly disclose: *determining from within the application program whether the image source device that is active is able to perform an automatic image scan*. However, Photoimpact discloses the display of an error message, if a selected device is not a TWAIN device, and if there is a TWAIN device, but it is not properly configured, then a dialog box containing configuration options appears (page163, line 8-17). In other words, when a user selects the acquire image button, instead of being able to automatically scan the image, the user is informed the automatic scan cannot be performed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoimpact, because Photoimpact discloses above the benefit of informing the user whether or not the device is properly configured.

Claim 17 is directed towards a computer-readable medium for storing the steps found in claim 12, and therefore is similarly rejected.

6. Claims 4-5, 18, 21-23, and 32-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99).

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Regarding claim 4, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2).

Wordperfect fails to explicitly disclose: *scanning a graphic source that has defined edges, further comprising the steps of automatically detecting the edges of the graphic source, and cropping the image at the edges of the graphic source to exclude any portion of a scanned field.*

However, Sobol discloses the selection of a specific portion of an image detecting the edges, thereby leaving unwanted data out, and cropping it to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches allowing the benefit of customizing a desired image by allowing the user to crop and select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired.

Regarding claim 5, which depends on claim 1, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2).

Wordperfect fails to explicitly disclose: *converting the data representing the image into a compressed format prior to inserting the data into the document.* However, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have

combined the teachings of Wordperfect, and Sobol, because Sobol teaches above the benefit of reduction of memory and processing time required to process the image.

Regarding independent claim 18, Wordperfect teaches the acquisition, transfer, and insertion of scanned images, from an *active* TWAIN scanner, under control of a wordprocessing application, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). The scanning, and insertion of the images is made using a scheme or a number of prescribed steps. Twain discloses a SAPI-- *a special application programming interface (API) module* --that allows a user's selection to trigger the providing of negotiated settings by a negotiation process between an application, describing the data it wants, and a source device, defining the data it can provide. In other words, the SAPI interface allows the application to direct the acquisition of an image through a "Source Manager" which contacts a "Source Driver"—*TWAIN module*-- which represents the hardware device used to acquire the image. The application has to go through the SAPI, and the "Source Manager" in order to access the "Source driver", thereby isolating the application from the driver—*independent of the TWAIN module*-- (page 4, lines 8-17, page 2, parag.4, page 3, parag.3-4).

Moreover, Wordperfect teaches the insertion of scanned images directly into a textual document without saving the images to a file prior to inserting them into the document (page 1). Wordperfect fails to explicitly teach *converting said data representing the selected image into a compressed format, and (e)*. Sobol discloses the compression of image(s), not compressed, before inserting in a document (col.4, lines 37-col.5, and line 18). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combine the

teachings of Wordperfect, Twain, and Sobol, because Sobol teaches above the benefit of reducing the amount of memory and processing time require to store, and process the images.

Regarding claim 21, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application, such as a slide presentation made up of individual slides (pages 1-2, 5).

Regarding claim 22, which depends on claim 18, Wordperfect teaches the editing, and adjusting—*enhancing*-- of scanned images, using image-editing tools incorporated within the wordprocessor (pages 3-4).

Claim 23 is directed towards a computer-readable medium for storing the steps found in claim 18, therefore is similarly rejected.

Regarding claim 32, which depends on claim 24, Wordperfect discloses allowing a user to choose a scanning device from a list for scanning—*activating*-- an image into a document, and displaying a dialog box for this selection based upon the type of scanner selected (page 2). Wordperfect fails to explicitly disclose: *the image is acquired by scanning a graphic source that has edges of the graphic source so as to automatically crop a scanned field included within the graphic source in the image, the image being so cropped prior to the data representing the image being inserted into the document.* However, Sobol discloses the selection of a specific

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portion of an image prior to inserting the image into a document, detecting the edges, thereby leaving unwanted data out, and cropping them to comply with the user's selection (col.4, lines 21-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Sobol, because Sobol teaches above, allowing the benefit of customizing a desired image by allowing the user to crop and select desired portions of the image. Therefore, a user would be able to select only the portion of an image(s) desired by a user.

Claim 33 is directed towards a system for implementing the steps found in claim 5, and therefore is similarly rejected.

7. Claims 7-8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10).

Regarding claim 7, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a contrast level of the image that is adjusted to enhance brightness*. However, Photoshop teaches the altering of an image contrast/brightness (p.8,L.1-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop

teaches above the benefit of increasing the legibility of a textual document. This would increase the legibility of the image obtained by the scanner, or device.

Regarding claim 8, which depends on claim 6, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancement criterion is a color level of the image...based on a gamma correction algorithm*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the benefit of customizing of an image to be compatible with the colors of a specific computer platform. This would increase the legibility of the image obtained by the scanner, or device.

8. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of "Troubleshooting and configuring the Windows NT/95 Registry", Clayton Johnson, hereinafter Johnson (1997, pp.1-2).

Regarding claim 11, which depends on claim 10, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to

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explicitly disclose: *a set of capabilities are associated with the image source devices...and are stored in an operating system registry*. However, Johnson teaches the settings and capabilities of hardware being stored in a computer's Windows registry (p.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Johnson, because Johnson teaches above storing hardware information in a registry to enable an operating system to control and run those devices.

9. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Photoimpact, and further in view of TWAIN specification version 1.8, 110/22/98, hereinafter Twain (IDS filed on 8/23/99).

Regarding claim 13, which depends on claim 12, Wordperfect teaches the scanning of an image into a document by simply choosing an "Acquire Image" menu option (page 1).

Wordperfect fails to explicitly disclose: *the device that is active has an X, and a Y resolution, and includes a driver that provides a user interface for selecting image capture parameters, (a) confirming that said image source device can control its X resolution; (b) confirming that said image source device can control its Y resolution; (c) confirming that the user interface can be bypassed, wherein an affirmative answer to all of the steps of confirming indicates that said image source device can perform the automatic image scan*. However, Twain teaches negotiating capabilities, such as X, Y resolution supported by a device (page 69, page 71, 14-31). Twain also teaches negotiating capabilities, such as the setting of certain x/y resolution, between a source device, and an application leads to a modification of a dialog, such as the graying out or

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bypassing of the dialog (page 116, lines 7-34, page 70, part 3). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Photoimpact and Twain; because Twain teaches the benefit of giving control to TWAIN applications (page 65, lines 16-20).

10. Claim 14 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, and in view of Twain, further in view of Photoimpact, and further in view of Arakawa (Pat. #5,845,076, 12/1/98).

Regarding claim 14, which depends on claim 12, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *setting an error flag*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status.

Furthermore, Wordperfect fails to explicitly disclose: *clearing the error flag if the automatic scan is successful, and evaluating the error flag..if the error flag has not been cleared*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process, and therefore the scanning cannot be completed (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have

combined the teachings of Wordperfect, and Arakawa, because Arakawa teaches above a scheme to discover the scanning status of a scanner, so that a user would be informed as to the status of the scanning job.

11. Claim 19 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol, and further in view of Photoshop (1998, pp.1-10).

Regarding claim 19, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the application program is a word processing application, and the plurality of images are inserted into the document as a plurality of tiled images*. However, Photoshop teaches the creation of graphics using a tiling technique (p.4,L.14-p.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop because Photoshop teaches above the benefit of the use of tiled images as a web page background, thereby enhancing a web page created with the wordprocessor.

12. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Sobol, and further in view of Hearn et al, hereinafter Hearn (Pat. # 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 20, which depends on claim 18, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *the plurality of inserted images are inserted into the spreadsheet document as a plurality of cascaded images*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

13. Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 26, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images into a textual document(s) located in the Wordprocessing application (pages 1-2, 6-7). Wordperfect fails to explicitly disclose: *the application program is a spreadsheet application*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the

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invention to have combined the teachings of Wordperfect, Sobol, and Hearn, because Hearn teaches above an improvement in the way to combine different data into a single document.

14. Claim 31 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wordperfect, in view of Twain, and further in view of Photoshop.

Regarding claim 31, which depends on claim 24, Wordperfect teaches the acquisition, transfer, and insertion of a scanned images, from an *active* TWAIN scanner, into a textual document(s) located in the Wordprocessing application (pages 1-2, 5). Wordperfect fails to explicitly disclose: *enhancing the quality of the captured image from within the application, the captured image quality being enhanced prior to inserting the data representing the image into the application program document*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Photoshop, because Photoshop teaches above the customization of an image to be compatible with the colors of a specific computer platform.

Response to Arguments

15. Applicant's arguments filed on 10/17/2005 have been fully considered but they are not persuasive.

In response to applicant's argument in regards to claims 1, 18, and 24, that the references fail to show certain features of applicant's invention, it is noted that the features upon which

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applicant relies (i.e., **“a SAPI within the TWAIN module”** page 9 line 16) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). These claims do not recite that the SAPI is located within the TWAIN module. However, the claims state that the SAPI is accessed from the application program to interface the application with the TWAIN module. Twain discloses a SAPI-- *a special application programming interface (API) module* --that allows a user's selection to trigger negotiated settings by a negotiation process between an application-- *causing the application program to negotiate*--, describing the data it wants, and a source device, defining the data it can provide. In other words, the SAPI interface allows the application to acquire an image through a “Source Manager” which contacts a “Source Driver”—TWAIN module-- which represents the hardware device used to acquire the image. The application has to go through the SAPI, and the “Source Manager” in order to access the “Source driver”, thereby isolating the user of the application from the driver of the acquisition device (page 4, lines 8-17, page 2, parag.4, page 3, parag.3-4). The SAPI is triggered by or from the application, and serves as an interface between the application, and the “Source Driver”—TWAIN module-- . It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Wordperfect, and Twain, and access the SAPI from within the application to communicate or interact with the driver, because Wordperfect discloses the acquisition of images from a scanner directly from the user using the TWAIN specification (page 1). Twain teaches providing a consistent, easy integration of image data between sophisticated input devices, and

software applications (page 1, parag. 2, page3, parag.2). Thus, easily and promptly scanning images into a document in real time.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning(page 10), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefore, claims 1-8, and 10-33 stand rejected at least based on the rationale of the newly applied rejection above.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

1/4/06